Question Q217

National Group:	ROMANIA
Title:	**The patentability criterion of inventive step / non-obviousness**
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Questions

I. Analysis of current law and case law

The Groups are invited to answer the following questions under their national laws:

Level of inventive step / non-obviousness

1. What is the standard for inventive step / non-obviousness in your jurisdiction? How is it defined?

The standard for the inventive step is stipulated as not being obvious to a person skilled in the art (Art. 12(1) of the Patent Law No. 64/1991 republished).

2. Has the standard changed in the last 20 years? Has the standard evolved with the technical / industrial evolution of your jurisdiction?

No significant changes have been made in the last 20 years. A new patent law entered in force in 1991, namely the Patent Law No. 64/1991, replacing the legislation specific for an ex-communist country with one harmonized with the European Patent Convention.

3. Does your patent-granting authority publish examination guidelines on inventive step / non-obviousness? If yes, how useful and effective are the guidelines?

NO

4. Does the standard for inventive step / non-obviousness differ during examination versus during litigation or invalidity proceedings?

Generally, the courts follow the Romanian State Office for Inventions and Trademarks (OSIM) standard for inventive step. However, the courts have total independence in taking a decision; therefore differences in appreciation are possible.

Construction of claims and interpretation of prior art

5. How are the claims construed in your jurisdiction? Are they read literally, or as would be understood by a person skilled in the art?

According to the Romanian legislation, the claims shall be clear and concise both individually and wholly, and they shall be supported by the description.
The claims should be drawn up in two parts and shall contain:
a) a preamble indicating the subject-matter of the invention and the technical features necessary for defining it and which, in combination, belong to the state of the art; and
b) a characterizing part, preceded by the expression "characterized in that", presenting the technical features which, in combination with the features stated in the preamble, define the claimed protection.
However, the claims may also be drawn up in a single part which contains the presentation of a technical feature or of a combination of more technical features which define the subject-matter for which protection is claimed (Art. 18(2)(3)(4) of the Implementing Regulations of the Patent Law No. 64/1991 republished).
The claims should be sufficiently clear and complete for it to be understood and carried out by a person skilled in the art (Art. 18(1) of the Patent Law No. 64/1991 republished).

6. Is it possible to read embodiments from the body of the specification into the claims?

YES

7. How is the prior art interpreted? Is it read literally or interpreted as would be understood by a person skilled in the art? Is reliance on inherent disclosures (aspects of the prior art that are not explicitly mentioned but would be understood to be present by a person skilled in the art) permitted?

The state of the art shall be held to comprise all knowledge that has been made available to the public by means of a written or oral description, by use, or in any other way before the filing date or the priority date of the patent application. It excludes the content of the patent applications filed with OSIM and international applications that have been entered the national phase in Romania or European patent applications designating Romania as filed, provided that their filing date is prior to the date referred above and they were published on or after that date (Art. 12(2) of the Patent Law No. 64/1991 republished).
The state of the art is interpreted as would be understood by a person skilled in the art.
The reliance on inherent disclosures could be permitted, but the patent application must contain sufficient technical information to allow a person skilled in the art to carry out the invention as claimed, without any inventive step, and if it allows the third parties to understand the contribution the claimed invention brings to the state of the art (Art. 37(1) of the Implementing Regulations of the Patent Law No. 64/1991 republished).

8. Do the answers to any of the questions above differ during examination versus during litigation?

Idem 4.

Combination or modification of prior art

9. Is it proper in your jurisdiction to find lack of inventive step or obviousness over a single prior art reference? If yes, and assuming the claim is novel over the prior art reference, what is required to provide the missing teaching(s)? Is argument sufficient? Is the level of the common general knowledge an issue to be considered?

Yes, it is proper in the Romanian jurisdiction to asses the inventive step of a patent application over a single prior art reference (closest prior art), especially when the problem-solution approach is used.
If the invention is novel over the prior art, in order to prove the inventive step, said invention must further comprise a solution to a technical problem for which the normal technological progress in the field is overcome, thus the solution is not directly and logically deducted from the prior art. For assessing the inventive step of an invention, the claimed teaching has to be considered as a whole, without being mentally divided into its constituent parts.
Yes, the level of the common general knowledge is an issue to be considered because the general knowledge is considered as being part of the state of the art.

10. What is required to combine two or more prior art references? Is an explicit teaching or motivation to combine required?

The Romanian legislation requires that the combination of two or more prior art references must be obvious for a person skilled in the art (Art. 47(5) of the Implementing Regulations of the Patent Law No. 64/1991 republished), but it does not mention any explicit teaching or any motivation to combine said references.

11. When two or more prior art references are combined, how relevant is the closeness of the technical field to what is being claimed? How relevant is the problem the inventor of the claim in question was trying to solve?

Although the Romanian legislation does not explicitly stipulate any relevance of the closeness of the technical field to what is being claimed, when two or more prior art references are combined, the inventive step of an invention shall be assessed in connection with the technical problem it solves (Art. 47(1) of the Implementing Regulations of the Patent Law No. 64/1991 republished), which implies a certain relevance of the belonging of the cited documents to the same or neighbouring technical field of the technical problem solved by what is being claimed.

12. Is it permitted in your jurisdiction to combine more than two references to show lack of inventive step or obviousness? Is the standard different from when only two references are combined?

Yes, when assessing the inventive step, there may be combined in mosaic system either more documents or parts of more documents, or different parts of the same document belonging to the state of the art and compared with the claimed invention, on condition that this combination is obvious for a person skilled in the art (Art. 47(4) of the Implementing Regulations of the Patent Law No. 64/1991 republished). There is no different standard.

13. Do the answers to any of the questions above differ during examination versus during litigation?

Idem 4.

Technical Problem

14. What role, if any, does the technical problem to be solved play in determining inventive step or non-obviousness?

The role of the technical problem to be solved played in determining inventive step is essential in combination with the solution disclosed by the invention. For instance, if the establishing of a technical problem of an invention would not be possible for a person skilled in the art having knowledge of all prior technical problems, then there is an indication of the inventive step.

15. To what degree, if any, must the technical problem be disclosed or identified in the specification?

According to the Romanian legislations, the specification has to contain the technical problem to be solved by the invention. However, if said technical problem is not explicitly mentioned in the specification, it has to result from the exposure of the invention as it is claimed, so that it may be understood by the person skilled in the art.

Advantageous effects

16. What role, if any, do advantageous effects play in determining inventive step or non-obviousness?

The advantageous effects are stipulated in the Romanian patent legislation as secondary considerations for assessing the inventive step. They may play a role, when necessary, in assessing the inventiveness.

17. Must the advantageous effects be disclosed in the as-filed specification?

Yes, the advantageous effect of the claimed invention has to be emphasized within the specification.

18. Is it possible to have later-submitted data considered by the Examiner?

According to the Romanian legislation, later-submitted data is possible to be considered by the examiner if they are filed with OSIM within 4 months from the date when at least one of the following documents has been filed with OSIM:
a) an explicit or implicit indication that the grant of a patent is requested;
b) indications serving to identify the applicant or to make possible for OSIM to contact him;
c) a part which should, at first sight, seem to be a description of the invention. OSIM shall consider the later-submitted data as included in the description, the application filing date shall be the date on which the later-submitted data has been filed with OSIM, and the applicant shall be notified accordingly (Art. 8(9) of the Implementing Regulations of the Patent Law No. 64/1991 republished).

19. How “real” must the advantageous effects be? Are paper or hypothetical examples sufficient?

The invention shall be disclosed in the patent application in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (for example to obtain the same advantageous effects any time when carrying out the invention). If not, the patent can be subjected to revocation or cancellation procedure.

20. Do the answers to any of the questions above differ during examination versus during litigation?

Idem 4.

Teaching away

21. Does your jurisdiction recognize teaching away as a factor in favor of inventive step / non-obviousness? Must the teaching be explicit?

The doctrine mentions teaching away as secondary consideration. The teaching must be explicit and widespread among the specialist in the field.

22. Among the other factors supporting inventive step / non-obviousness, how important is teaching away?

Due to the high level of difficulty in proving the teaching away, it would be recommended not to use it. Its importance is lower than other secondary considerations, such as the surprising effect etc.

23. Is there any difference in how teaching away is applied during examination versus in litigation?

Idem 4.

Secondary considerations

24. Are secondary considerations recognized in your jurisdiction?

YES

25. If yes, what are the accepted secondary considerations? How and to what degree must they be proven? Is a close connection between the *claimed* invention and the secondary considerations required?

The Romanian patent legislation stipulates the following secondary considerations:
a) the non-obvious use of known means for another purpose while producing novel and surprising effects:
b) a novel use of a known device or material which obviates technical difficulties impossible to surpass in a known manner;
c) a combination of new or known features, carried out in such a manner that they mutually intensify their effects and a new technical result is obtained;
d) a selection, within a process, of those technical parameters contained in a known range, which produce unexpected effects on the carrying out of the process or on the properties of the product obtained;
e) a selection within a very large group of compounds of known chemical combinations of those that have unexpected advantages;
f) the use of technical means of the claimed invention for solving the technical problem on another way than the one resulting from the documents contained in the state of the art analyzed by the person skilled in the art.
In all these cases, a strong argumentation is necessary. A close connection between the claimed invention and the secondary considerations is required.

26. Do the answers to any of the questions above differ during examination versus during litigation?

During litigations the court may take into account more secondary considerations, such as: formulation of the technical problem, long-felt need, the efforts of the specialists, research activity, technical progress, licensing and commercial success, imitation, arbitrary choice, unexpected technical effect, bonus effect, teaching away, advantageous effects, reducing costs, the number of opposable documents.

Other considerations

27. In addition to the subjects discussed in questions 4 - 26 above, are there other issues, tests, or factors that are taken into consideration in determining inventive step / non-obviousness in your jurisdiction?
If yes, please describe these issues, tests, or factors.

A modality for assessing the inventive step in the Romanian patent legislation is the problem-solution approach, comprising the following steps:
a) determining the closest state of the art;
b) establishing the objective technical problem to be solved;
c) evaluating in so far as, starting from the closest state of the art and from the objective technical problem, the claimed invention would have been obvious for the person skilled in the art on the relevant date.

Test

28. What is the specific statement of the test for inventive step/non-obviousness in your jurisdiction? Is there jurisprudence or other authoritative literature interpreting the meaning of such test and, if so, provide a brief summary of such interpretation.

The problem-solution approach is interpreted in the doctrine as a test by which the assessment of the inventive step should be as objective as possible and is mainly based on the technical evaluation of the inventiveness of the claimed invention related to the closest prior art. In the same time, there is no need to asses the inventive step of the invention taking into consideration a less relevant prior art. On the other hand, the assessment of the inventive step of an invention based on one document considered the closest prior art could lead to an artificially restriction of the examination of the inventive step.

29. Does such test differ during examination versus during litigation?

Idem 4.

Patent granting authorities versus courts

30. If there are areas not already described above where the approach to inventive step / non-obviousness taken during examination diverges from that taken by courts, please describe these areas.

There are no such areas.

31. Is divergence in approach to inventive step / non-obviousness between the courts and the patent granting authority in your jurisdiction problematic?

NO.

Regional and national patent granting authorities

32. If you have two patent granting authorities covering your jurisdiction, do they diverge in their approach to inventive step / non-obviousness?

No, the Romanian patent legislation is harmonized with the European Patent Convention.

33. If yes, is this problematic?

II. Proposals for harmonization

The Groups are invited to put forward proposals for the adoption of harmonised rules in relation to the patentability criteria for inventive step / non-obviousness. More

specifically, the Groups are invited to answer the following questions without regard to their national laws:

34. Is harmonization of inventive step / non-obviousness desirable?
YES

35. Is it possible to find a standard for inventive step / non-obviousness that would be universally acceptable?
In our opinion, the inventive step is a complex examination criterion which also comprises some uncertanties. Therefore, an universally acceptable standard for inventive step would be very hard to reach.

36. Please propose a definition for inventive step / non-obviousness that you would consider to be broadly acceptable.
An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.

37. Please propose an approach to the application of this definition that could be used by examiners and by courts in determining inventive step / non-obviousness.
The combination in mosaic system of either more documents or parts of more documents, or different parts of the same document belonging to the state of the art and compared with the claimed invention, on condition that this combination is obvious for a person skilled in the art.

ABSTRACT

For assessing the inventive step by the way of the problem-solution approach, the Romanian patent legislation comprises the following steps:
a) determining the closest state of the art;
b) establishing the objective technical problem to be solved;
c) evaluating in so far as, starting from the closest state of the art and from the objective technical problem, the claimed invention would have been obvious for the person skilled in the art on the relevant date.

When the problem-solution approach is used to asses the inventive step of a patent application, a single prior art reference will be considered as the closest prior art.
The problem-solution approach is interpreted in the doctrine as a test by which the assessment of the inventive step should be as objective as possible and is mainly based on the technical evaluation of the inventiveness of the claimed invention related to the closest prior art. At the same time, there is no need to asses the inventive step of the invention taking into consideration a less relevant prior art. On the other hand, the assessment of the inventive step of an invention based on one document considered to be the closest prior art could lead to an artificially restriction of the examination of the inventive step.

If the invention is novel over the prior art, in order to prove the inventive step, said invention must further comprise a solution to a technical problem, exceeding the normal technological progress in the field, thus the solution is not directly and logically deducted from the prior art.

For assessing the inventive step of an invention, the claimed teaching has to be considered as a whole, without being mentally divided into its constituent parts.
The level of the common general knowledge is an issue to be considered due to the fact that the general knowledge is considered as being part of the state of the art.
Our proposal for the definition of inventive step / non-obviousness is the following: “an invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art”.
In determining the inventive step / non-obviousness, the combination in mosaic system, either of several documents or parts of more than one document, or different parts of the same document, belonging to the state of the art can be used, followed by comparing them with the claimed invention, provided that this combination is obvious for a person skilled in the art.

RESUME

Afin d'évaluer l'activité inventive par la voie de l'approche problème-solution, la législation roumaine sur les brevets comprend les étapes suivantes:
a) la détermination de l'état de la technique le plus proche;
b) établir le problème technique objectif à résoudre;
c) évaluer en quelle mesure, à partir de l'état de la technique le plus proche et du problème technique objectif, l'invention revendiquée aurait été évidente pour l'homme du métier à la date pertinente

Lorsque l'approche problème-solution est utilisée pour évaluer l'activité inventive d'une demande de brevet une référence unique de l'état de la technique sera considérée comme la l'état de la technique le plus proche.
L'approche problème-solution est interprétée dans la doctrine comme un test par lequel l'évaluation de l'activité inventive doit être aussi objective que possible et est principalement basée sur l'évaluation technique de l'inventivité de l'invention revendiquée liée à la technique la plus proche. Au même temps, il n'est pas nécessaire d'évaluer l'activité inventive de l'invention en tenant compte d'un art moins pertinent. D'autre part, l'évaluation de l'activité inventive d'une invention fondée sur un document considéré être l'état de la technique le plus proche pourrait conduire à une restriction artificielle de l'examen de l'activité inventive.

Si l'invention est nouvelle par rapport à l'art antérieur, afin de prouver l'activité inventive, cette invention doit comprendre en outre une solution à un problème technique pour lequel le progrès technologique normale dans le domaine est résolu, donc la solution n'est pas directement et logiquement déduite de l'art antérieur. Pour évaluer l'activité inventive d'une invention, l'enseignement revendiqué doit être considéré comme un tout, sans être mentalement divisé en ses éléments constitutifs.
Le niveau des connaissances générales est une question à prendre en considération puisque que la connaissance générale est considérée comme faisant partie de l'état de l'art.
Notre proposition pour la définition de l'activité inventive est telle: une invention est considérée comme impliquant une activité inventive si, compte tenu de l'état de l'art, elle n'est pas évidente pour une personne du métier.
Afin de déterminer l'activité inventive peut être utilisée la combinaison de plusieurs documents, des parties des plusieurs documents ou bien des différents parties du même document appartenant à l'état de l'art, à condition que cette combinaison soit évidente pour l'homme du métier et qu'elle puisse se rapporter à l'invention revendiquée.

ZUSAMMENFASSUNG

Für die Beurteilung der erfinderischen Tätigkeit durch den Aufgabe-Lösungs-Ansatz umfasst das rumänische Patentrecht die folgenden Schritte:
a) Bestimmung des nächstliegenden Stands der Technik;
b) Formulierung der zu lösenden objektiven technischen Aufgabe;
c) Bewertung ob, ausgehend vom nächsten Stand der Technik und von der objektiven technischen Aufgabe, die beanspruchte Erfindung für den Fachmann zum betreffenden Zeitpunkt naheliegend gewesen wäre.

Wenn der Aufgabe-Lösungs-Ansatz verwendet wird, um die erfinderische Tätigkeit einer Patentanmeldung zu bewerten, wird ein einzelnes Dokument als nächster Stand der Technik betrachtet.

Der Aufgabe-Lösungs-Ansatz gilt in der Lehre als ein Test, durch den die Beurteilung der erfinderischen Tätigkeit so objektiv wie möglich sein soll, und basiert vor allem auf der technischen Bewertung der erfinderischen Tätigkeit der beanspruchten Erfindung im Verhältnis zum nächstliegenden Stand der Technik. Dabei ist es nicht notwendig, die erfinderische Tätigkeit der Erfindung unter Berücksichtigung eines weniger relevanten Stands der Technik zu beurteilen. Andererseits könnte die Beurteilung der erfinderischen Tätigkeit einer Erfindung basierend auf einem einzigen Dokument, das als nächstliegender Stand der Technik betrachtet wird, zu einer künstlichen Beschränkung der Prüfung der erfinderischen Tätigkeit führen.

Ist die Erfindung neu gegenüber dem Stand der Technik, muss sie, um auch erfinderisch zu sein, außerdem eine Lösung einer technischen Aufgabe beinhalten, die den normalen technologischen Fortschritt auf dem Gebiet übertrifft, die Lösung ist also nicht unmittelbar und logisch aus dem Stand der Technik abzuleiten.
Für die Beurteilung der erfinderischen Tätigkeit einer Erfindung muss die Lehre des Stands der Technik als Ganzes betrachtet werden, ohne sie geistig in ihre Bestandteile aufzuteilen. Das Niveau des allgemeinen Fachwissens ist ein Thema, das berücksichtigt werden muss, da das allgemeine Fachwissen zum Stand der Technik gehört.
Unser Vorschlag für die Definition von erfinderischer Tätigkeit ist der folgende: Eine Erfindung soll als erfinderisch betrachtet werden, wenn sie für einen Fachmann in Kenntnis des Standes der Technik nicht naheliegend ist.
Zur Beurteilung der erfinderischen Tätigkeit können mehrere Dokumente, Teile von mehreren Dokumenten oder verschiedene Teile eines einzigen Dokuments aus dem Stand der Technik miteinander kombiniert werden, sofern diese Kombination für den Fachmann naheliegend ist, und danach mit der beanspruchten Erfindung verglichen werden.